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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/771,819

02/04/2004

Edward H. Overstreet

AB-388U

3954

23845 7590 12/19/2006
ADVANCED BIONICS CORPORATION
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EXAMINER

GEDEON, BRIAN T

ART UNIT

PAPER NUMBER

3766

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/19/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/771,819

Applicant(s)

OVERSTREET ET AL.

Examiner

Brian T. Gedeon

Art Unit

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-11,13 and 15-19 is/are rejected.
- 7) ☒ Claim(s) 3-7,12,14 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/1/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a flowchart or block diagram depicting the claimed method must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 8-11, 13, 15-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Stecker et al. (US Patent no. 6,915,166).

In regard to claims 1, 13, and 15, Stecker et al. describe a neural stimulator device and method for measuring the evoked response due to electrical stimulation of tissue, and calculating a value for relating stimulus levels to response level for each electrode, col 1 lines 52-57. The method consists of applying a various stimulus level for an electrode, then measuring the amplitude of the evoked response to a set of stimuli at different stimulation levels for one of the electrodes in the prosthesis, calculating a value relating to the evoked responses to the stimulus levels for each electrode, and then repeating the process for each electrode for which data is required, col 1 lines 59-67 through col 2 lines 1-5. Stecker et al. teach that growth curves are valuable for determining the effects of stimulation intensity and stimulation site on the evoked potentials, col 2 lines 33-52, and thus implies that the data ascertained from the method would be used in constructing a growth curve. Stecker et al. also propose performing the process with combinations of electrodes, col 2 lines 10-12. The neural stimulator is comprised of an electrode array, col 4 lines 59-60, and for each stimulus applied, a recording is made. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method as a way of

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improving cochlear implant fitting by locating there the greatest evoked neural response due to stimulation level and electrode location.

In regard to claim 2, Stecker et al. record evoked potentials for different stimulation levels, it would therefore have been obvious to one of ordinary skill in the art since variation of electrical stimulation levels, regardless of amplitude variations or pulse width variation, would involve routine skill in the art.

In regard to claims 8, 9, and 16, the device and method by Stecker et al. is a neural stimulator device that is capable of stimulating nerve tissue, cochlear however pertains primarily to cochlear nerve tissue.

In regard to claims 10 and 17, it would not be beyond one of ordinary skill in the art to be able to adjust the amount of pulses/stimuli in a stimulation pulse train since it would only involve routine skill and experimentation in the art.

In regard to claims 12 and 18, it would not be beyond one of ordinary skill in the art to be able to adjust the time delay between stimulation and recording since it would involve would only involve routine skill and experimentation in the art.

In regard to claim 19, it would not be beyond one of ordinary skill in the art to make use of a monopolar electrode since monopolar electrodes are well known in the stimulation art and would therefore be a matter of design choice to choose a monopolar electrode over one of the other know variants of stimulation electrodes.

Allowable Subject Matter

3. Claims 3-7, 12, 14, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Den Honert et al. (US Patent no. 6,751,505) describes a method for optimizing the operation of a cochlear implant by measuring evoked potentials resulting from electrical stimulation.

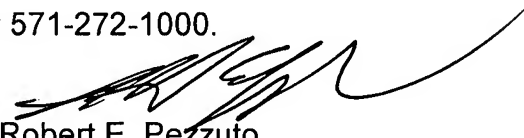
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. Gedeon whose telephone number is (571) 272 3447. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272 6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian T. Gedeon
Patent Examiner
Art Unit 3766



Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3766

BTG